

Appl. No. 09/606,617
Reply dated July 2, 2003
Reply to Office Action of May 7, 2003

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REMARKS/ARGUMENTS

Status of the Application:

Claims 1-51 are pending in the application. In a final office action dated May 7, 2003 (Paper # 12), all pending claims were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,805,587 (Norris) in view of U.S. Patent No. 5,796,806 (Birckbichler). This reply neither adds, cancels nor amends any claims. Hence, after entry of this reply, claims 1-51 remain pending in the application.

Rejected claims:

The final office action maintained the rejections of claims 1-51 from an earlier office action (Paper #10), despite the applicant's argument that the cited references fail to state a *prima facie* case of obviousness under § 103(a). The applicant respectfully requests reconsideration of those rejections, at least for the reasons stated in his previous reply (Paper #11), as well as for the following additional reasons.

The final office action asserts that, given the knowledge generally available to one of ordinary skill in the art, it would have been obvious to combine the teachings of Norris and Birckbichler. The applicant continues, however, to respectfully disagree with that assertion. As stated earlier, it is only in hindsight that the combination of these two disparate teachings appears obvious. In addition, the proposed combination fails to create a *prima facie* case of obviousness for at least two additional reasons: First, any asserted motivation or suggestion in the prior art to combine the cited references is vitiated by the references themselves, which in fact teach away from the asserted combination. Moreover, the combination of the references would be inoperable to accomplish the limitations of, for instance, claim 1, which recites, *inter alia*, "receiving an audible identification from the caller; and . . . providing the audible identification via the computer network and the subscriber line to the device."

First, Norris teaches away from any combination of that reference with Birckbichler, in that Norris contemplates forwarding all calls to a separate Internet Access Service to provide

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caller notification, while Birckbichler requires that the PSTN retain control over the call in order to provide spoken caller ID services. By way of example, consider the disclosures contained in each of those references. Upon careful examination, the Norris and Birckbichler references reveal fundamental technological differences that not only teach away from their combination but in fact would prevent any operable combination.

Birckbichler utilizes the components of a public switched telephone network (PSTN) (in particular, an Advanced Intelligent Network (AIN)), and in fact depends on an Intelligent Peripheral (IP) of such a network to provide audible caller ID services. In contrast, Norris forwards the call outside of the PSTN to a separate Internet Access Service (IAS), which handles the call from that point forward and provides all of the disclosed online caller ID services.

Thus, on the one hand, the cited portion of Birckbichler (col. 2, lns. 31-36, 50-51 and 64-67)

"uses the information and voice processing capabilities of an AIN Intelligent Peripheral and the signaling capabilities of the Common Channel Signaling System (SS#7 at present) network to provide the spoken caller ID service. . . . The intelligent peripheral can interactively collect information for the caller . . . [and] will verbally state the name of the caller to the subscriber (assuming the caller's name is available in a textual format) and query the subscriber for how he/she wishes to handle the call."

Hence, the cited portion of Birckbichler discloses the use of an AIN, and in particular an IP, to provide the spoken caller ID service and the PSTN at all times maintains control of the call. This is important, because Birckbichler provides for the spoken caller ID service to be provided to a subscriber while that subscriber is on the telephone. Necessarily, then, all of the processing and signaling necessary to provide the feature takes place within the telephone network, because the spoken caller ID feature is a voice service, implemented within the constraints of a conventional voice network. (Notably, although Birckbichler does mention non-AIN telephone networks, such as a pre-AIN PSTN and a cellular network, these still are voice networks.)

On the other hand, Norris contemplates a data service, for which the PSTN traditionally is less well-suited. To augment the PSTN, therefore, Norris (col. 5, lns. 53-61) teaches the use of a separate Internet Access Service, which serves both to provide Internet access to the subscriber and to provide notification of incoming calls, and which effectively assumes control of all

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incoming calls to the subscriber. Thus, Norris discloses what basically amounts to a call forwarding system, such that, if a call for a subscriber is received via the PSTN at a central office (CO) while the subscriber is online,

"CO 25 determines that station S1 is busy and that call forwarding has been activated at station S1. As such CO 25, in a conventional manner, directs the call to IAS 200 in accord with the call forwarding telephone number that CO 25 received as interacting with IAS 200 in the manner discussed above. In doing so, CO 25 sends a message to TS 105 requesting a rerouting of the station S2 call and containing the IAS 200 telephone number as the destination for such rerouting."

Thus, the system of Norris functions basically to forward the incoming call out of the PSTN to a separate Internet Access Service (200), according to the telephone number of the IAS. That the IAS is not a part of the PSTN can be ascertained both from the above-quoted passage and an examination of Fig. 1. Consequently, the only functionality exhibited by the telephone network (PSTN) is to forward the call to a separate Internet Access Service, which even has its own telephone number. In other words, the telephone network does little (if anything) but determine that the subscriber is online, and if so, forward calls to the Internet Access Service. Thereafter, the IAS handles the notification of the subscriber, as well as controls the disposition of the call. As mentioned above, the IAS is not part of the PSTN and thus would not be considered an Intelligent Peripheral. Instead, the IAS is a separate service, sitting outside the PSTN, that the subscriber uses to connect to the Internet. *See Norris, col. 2, lns. 15-20; Fig. 1.*

Thus, while Birckbichler teaches the use of the PSTN (and specifically, an AIN) to perform Birckbichler's spoken caller ID function, Norris teaches away from using an intelligent network (or any other PSTN) to perform its online notification function; while Norris' system uses the PSTN to forward calls to the IAS, it is the IAS (which, as discussed above, is separate from the PSTN) that actually performs the online notification. Norris, therefore, teaches away from using a voice network (and, specifically, an intelligent peripheral) to perform its notification function, while Birckbichler requires a voice network for its own spoken caller ID feature. Norris, in effect, teaches away from any combination of that reference with Birckbichler.

The office action, acknowledging that the references themselves fail to provide any motivation for their combination, asserts that "the knowledge generally available to one of

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ordinary skill in the art" provides such a suggestion or motivation to combine Norris with Birckbichler. To the extent the general knowledge in the art did provide any motivation to combine (which it does not), that motivation would be destroyed by Norris' teaching away from the combination. (For that matter, Norris fails to disclose, and in fact teaches away from, many of the dependent claims, including, for instance, claim 11, which is directed to, *inter alia*, "an intelligent peripheral (IP) sending the audible identification via the computer network to the subscriber line.")

In fact, it is difficult to see how these two disparate systems could be combined at all with any reasonable expectation of success. For instance, in the system of Norris (col. 4, lns. 22-60), the call-forwarding feature is activated when the subscriber goes online, before any incoming call ever is received, such that an incoming call is forwarded automatically to the IAS, which assumes further control of the call. That automatic forwarding and control feature, however, which is critical to the operation of Norris, would prevent the IP of Birckbichler from accessing the incoming call and performing its functions (collecting information from the caller and audibly informing the subscriber about the caller's information), rendering any combination of Norris and Birckbichler inoperable. For this additional reason, the asserted combination fails to create a *prima facie* case of obviousness under §103.

Notably, neither reference teaches or suggests the use of anything but Norris' separate Internet Access Service to provide notification to an online subscriber; in particular, neither reference teaches that an IP could perform this function. Likewise, neither reference teaches the use of anything but Birckbichler's Advanced Intelligent Network (and, specifically, an intelligent peripheral) to provide spoken caller ID functionality. Thus, the applicant can ascertain no combination of the cited references that would be operable to "provid[e] the audible information via the computer network and the subscriber line" as claimed, for instance, in claim 1. In a combined system, if a subscriber were online, a call to that subscriber automatically would be forwarded to an IAS, according to the teaching of Norris. The call would never have a chance to be processed by an IP within the network of Birckbichler, and the IAS of Norris includes no disclosed or suggested ability to provide any sort of audible notification. In short, the cited

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combination fails to teach or suggest any operable way to use a PSTN to provide any caller ID services to an online subscriber, let alone any audible caller ID services—the only disclosed (or even suggested) way to provide any online caller ID services is through a separate Internet Access Service, which precludes the use Birckbichler's IP to provide the audible caller ID feature. Conversely, Birckbichler's IP is the only disclosed way to provide audible caller ID services, and there is no teaching or suggestion that it might be operable with Norris' IAS.

In contrast, the present application does teach, *inter alia*, a novel way to use/modify an AIN to provide audible notification to a subscriber while that subscriber is online. At the very least, therefore, the present application provides the necessary disclosure to fill the gap between the teachings of Norris and Birckbichler. Thus, it is only the disclosure of the present application that teaches an operable system for providing audible caller identification via a computer network and subscriber line.

The inventive concepts in the present application provide several benefits over both Norris and Birckbichler. For instance, because, in certain aspects, the present application does not require the transfer of a call outside the PSTN to provide call waiting functionality (as does Norris), common AIN components can be used, allowing, *inter alia*, for more flexibility in call-handling options. Merely by way of example, in an embodiment disclosed at page 7, lines 15-20 of the application, after listening to the audible identification of the caller, the subscriber can choose to take the call either over the Internet or via the subscriber line. This feature presumably is unavailable in the system of Norris: Once the call has been forwarded to the IAS, the only way Norris (*see* col. 7, ln. 1 through col. 8, ln. 5) discloses for the subscriber to take the call is via Internet telephony; because the IAS, not the PSTN, now handles the call, there would be no way for the subscriber to take the call via the subscriber line. Clearly, in forwarding the call to the separate Internet Access Service, Norris operates fundamentally differently than, for example, Birckbichler, in which the PSTN maintains control over the call. As discussed above, therefore, any combination of Norris with Birckbichler necessarily would be inoperable.

Thus, the disclosures of Norris and Birckbichler teach away from their combination, eliminating any possible motivation that the art could provide to combine the references. Indeed,

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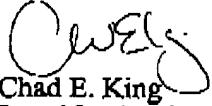
the combination of Norris with Birckbichler would meet with no reasonable expectation of success, so even if there were some motivation or suggestion to attempt to combine the references (and, as noted above and in the earlier reply, there is not), that combination would fail to create a *prima facie* case of obviousness with respect to the claims of the present application. For at least these reasons, the applicant respectfully requests reconsideration of the rejections under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, the applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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